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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,126	09/27/1999	ROBERT W. BOSSEMEYER JR.	8285/314	2323
757 7590 01/25/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/407,126

Applicant(s)

BOSSEMEYER ET AL.

Examiner

Igor N. Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-12, 14-19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-12, 14-19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 11/02/06 is acknowledged and entered. Claims 1, 9, 10, 17, 27-30 have been amended. Claims 1-3, 5-12, 14-19, 21-30 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, 14-19 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcott (US 6,324,273) in view of Majmudar et al. (US 4,897,866) (Majmudar).

### **Independent Claims**

As per claims 1, 10 and 17, Alcott teaches a computer-implemented method and system for ordering a telecommunication service, comprising:

determining, in accordance with an inquiry of the originating first party, an availability of a telecommunication feature for the party of a telecommunication network (C. 3, L. 62 - C. 4, L. 4);

identifying the party of the telecommunication network and the telecommunication feature unavailable to the party in accordance with said inquiry (C. 3, L. 48 - 53; C. 3, L. 62 - C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 - C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).

Alcott does not explicitly teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first transaction; and after upgrading the portion of the telecommunication network which serves the party. Also, while Alcott teaches informing the first party that the first telecommunication feature is available (creating an account and providing a billing record to the originating party)(C. 4, L. 25-30), wherein said "informing" occurs in response to the inquiring in the first transaction, Alcott does not specifically teach that said "informing" step includes informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data.

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event (indicates after completion of the first transaction), if user lifts a handset to originate a call, the terminal will display the requested new feature (indicates informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data), and wherein placing the call to

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inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature." (Abstract; C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction; upgrading the network which serves the first party to provide the requested by the first party the telecommunication feature; and informing the first party that the first telecommunication feature has become available, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.

As per claim 9, Alcott teaches:

determining an availability of a telecommunication feature for the originating first party of a telecommunication network in accordance with an inquiry of a party (C. 3, L. 2 - C. 4, L. 4);

storing a first data structure which identifies the party of the telecommunication network and the telecommunication feature unavailable to the party in accordance with said inquiry (C. 3, L. 48- 53; C. 3, L. 62 - C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 2 - C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48-53).

Alcott does not explicitly teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first transaction; and after upgrading the portion of the telecommunication network which serves the party. Also, while Alcott teaches informing the first party that the first telecommunication feature is available (creating an account and providing a billing record to the originating party)(C. 4, L. 25-30), wherein said "informing" occurs in response to the inquiring in the first transaction, Alcott does not specifically teach that said "informing" step includes informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data.

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event (indicates after completion of the first transaction), if user lifts a handset to originate a call, the terminal will display the requested new feature (indicates informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data), and wherein placing the call to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature." (Abstract; C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction; upgrading the network which serves the first party to provide the requested by the first party the telecommunication feature; and informing the first party that the first telecommunication feature has become available, as taught by Majmudar,

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because it would advantageously allow to accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.

Also, Alcott and Majmudar does not specifically teach that said originating party includes a first, a second and a third party, and that said inquired feature includes a first, a second and a third feature. However, the method steps disclosed in Alcott and Majmudar indicate continuity of the disclosed method, because it is not feasible to implement said system for one customer only and only for one feature. Furthermore, the method steps, disclosed in Alcott and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service. Thereby, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Majmudar to include that said originating party includes a first, a second and a third party, and that said inquired feature includes a first, a second and a third feature, because it would advantageously allow to accommodate various needs of all subscribers.

#### Dependent Claims

Furthermore, Alcott teaches:

As per claims 2, 11 and 18,

identifying another party of the telecommunication network and another a telecommunication feature unavailable to another party; determining an availability of the telecommunication feature for another party of a telecommunication network; and determining that the telecommunication feature unavailable to another party (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).

As per claims 3, 12 and 19, identifying another party of the telecommunication network and another telecommunication feature unavailable to another party; and determining that another telecommunication feature unavailable to another party (C. 3, L. 48 -53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53). As to second party and first telecommunication feature, the method steps, disclosed in Alcott and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per claim 5, said method and system, comprising: prior to inputting the availability data,

receiving a call from the party, and informing in the call that the first telecommunication feature is unavailable to the party (C. 1, L. 11-33; C. 3, L. 41 - C. 4, L. 4).

As per claims 6, 14 and 21, said method and system, wherein the first telecommunication feature comprises a telecommunication service (C. 1, L. 6-7).

As per claims 7, 15 and 22, said method and system, wherein the first telecommunication feature comprises a telecommunication product (C. 1, L. 6-7).

As per claims 8, 16 and 23, said method and system, wherein the telecommunication network comprises a telephone network (C. 1, L. 62 - C. 2, L. 12).

As per claims 24-30, See reasoning applied to the independent claims.

### ***Response to Arguments***

Applicant's arguments filed 11/02/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose that "placing the call to inform the first party that the first telecommunication feature has become



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available occurs before the first party has subscribed to the first telecommunication feature", it is noted that Mujmudar explicitly teaches said feature. Specifically, Majmudar teaches displaying a list of all possible telephone features available to the subscriber terminal together with an indication of currently subscribed features (Abstract).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

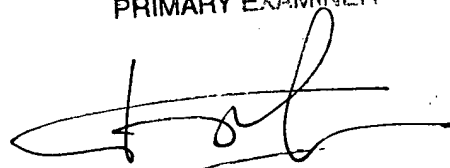
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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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01/21/2007

IGOR N. BORISSOV  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'I. N. Borissov', written over the printed name and title.